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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,027	10/21/2003	John Hurd	005127.00348	4984
22907	7590	03/10/2006	EXAMINER	
BANNER & WITCOFF 1001 G STREET N W SUITE 1100 WASHINGTON, DC 20001			PATTERSON, MARIE D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

YD

<b>Office Action Summary</b>	<b>Application No.</b> 10/691,027	<b>Applicant(s)</b> HURD ET AL.	
	<b>Examiner</b> Marie Patterson	<b>Art Unit</b> 3728	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 27 January 2006.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-9, 11-13, 15-18, 20-26, 28-32, 34-37 and 39 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-7, 9, 11-13, 15-18, 20, 21, 23, 24, 26, 28-32, 34, 35, 37 and 39 is/are rejected.

7) ☒ Claim(s) 8, 22, 25, and 36 is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-6, 9, 11-13, 15-18, 20, 21, 23, 26, 28, 29, 32, 34, 35, 37, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Ogle (5282327).

Ogle shows a spring member (16 and 36), an arm (12/16), and a heel retaining element (14) and the inherent method of use as shown in the figures as claimed.

3. Claims 1-7, 9, 11-13, 15-18, 20, 21, 23, 24, 26, 28-30, 32, 34, 35, 37, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Balut (2693039).

Balut shows a spring member (28) with an exterior edge (outer edge/surface of 28) and with a hole (center of spiral form), an arm (side portions of elements 26), a heel

retaining element (top of elements 26), an interface (24), a footbed (18), and a midsole (12) and the inherent method of use as shown in the figures as claimed.

4. Claims 1-3, 5, 6, 9, 15-17, 20, 23, 26, 28, 29, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Miller (2746178).

Miller shows a spring member (figures 4) with an outer edge (at a and c), an arm (21 and 24), an outsole (21a) and midsole (20) as shown in the figures as claimed.

#### ***Allowable Subject Matter***

5. Claims 8, 22, 25, and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

6. Applicant's arguments filed 1/27/06 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards Ogle, the spring/device shown by Ogle is considered to be bimodal inasmuch as applicant has claimed such in that it does have two stable positions with edges in two positions as shown in figures 1 and 2.

In response to applicants' arguments directed towards Balut, the spring/device shown by Balut is considered to be bimodal inasmuch as applicant has claimed such in that it does have two stable positions with edges (outer portions of 28) in two positions in that the edges move and therefore are at two different positions when moved and the sides of 26 extend from the outer surface (i.e. edges) of element 28.

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In response to applicants' arguments directed towards Miller, the spring/device shown by Miller is considered to be bimodal inasmuch as applicant has claimed such in that it does have two stable positions with edges (at a and c) in two positions and arms (21 and 24) which extend therefrom.

1. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (572)272-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Marie Patterson of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Marie Patterson whose telephone number is (571) 272-4559. The examiner can normally be reached from 6AM - 4PM Mon-Wed.



Marie Patterson  
Primary Examiner  
Art Unit 3728